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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Shafer , et al.	
Application No.: 10/789,781	Group Art Unit: 1711
Filed: 2/27/2004	Examiner: T. Boykin
Title: Liquid crystal polycarbonates and methods of preparing same	Confirmation No: 9454
Attorney Docket No.: GEPL.P-093	
Customer No.: 021121	

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

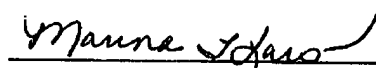
RESPONSE TO OFFICIAL ACTION

Dear Sir:

This is in response to the Office Action mailed July 23, 2004 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Claims 1-48 stand rejected as anticipated by and claim 49 as obvious over US Patent No. 6,518,391. Applicants respectfully traverse this rejection.

I hereby certify that this paper and any attachments named herein are transmitted to the United States Patent and Trademark Office, Fax number: 703-872-9306 on October 22, 2004.


Marina T. Larson, PTO Reg. No. 32,038

October 22, 2004
Date of Signature

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Amendment Dated: October 22, 2004
Reply to Office Action of July 23, 2004

As the examiner has acknowledged, the claims of this application relate to **liquid crystal polycarbonates**. The cited reference relates to **partially crystalline polycarbonates**. The Examiner apparently equates these two, as reflected on Page 5 of the Office Action, where it is asserted that "the reference discloses a liquid crystal polycarbonate or a partially crystalline oligomeric polycarbonate." This is incorrect, because the two terms do not mean the same thing.

The term "liquid crystal" has nothing to do with crystallinity. Rather, as defined on Page 1 of the present specification, "liquid crystalline materials are materials that in a liquid state display anisotropic, i.e., ordered, molecular arrangements." Crystalline materials, or partially crystalline materials have ordered arrangements in a **solid phase**. Thus, the disclosure of partially crystalline materials is not a disclosure of liquid crystals. It is noted that the present application teaches specific components that give rise to liquid crystalline materials, and that no example of the cited reference includes this combination. Thus the rejection is in error and should be withdrawn.

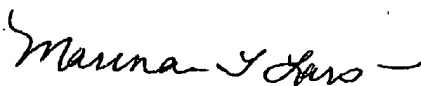
Furthermore, the present claims require at least two species of aromatic diol selected from among a list of only 8 choices. The cited reference on the other hand has a long list of aromatic diols. This list includes many diols that are not among the 8 listed in applicants' claims. Further, the diols may also be used individually as well as in unspecified "combinations." There is no express teaching of any combination that would meet the limitation of the claims of this application. The mere fact that a few of the possible combinations from the reference may fall within the scope of the present claims is not sufficient to establish anticipation or obviousness.

As explained in *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972), for an anticipation rejection to be proper, the reference "must unequivocally disclose the claimed compound or direct those skilled in the art to the claimed compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." This means that where there are long lists of options to choose from, anticipation can only be found where the teaching of the reference guides the person skilled in the art to make the necessary choices to reach a combination that is later claimed. This is not the case here, since the reference expressly discloses no combinations even remotely similar to the claimed composition. Furthermore, the absence of this disclosure makes it clear that the choices necessary to reach the claimed invention are not obvious over the claimed invention.

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For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited. Applicants further note that the Examiner has not confirmed consideration of the Information Disclosure Statement filed July 13, 2004. Return of an initialed copy of the Form 1449 with the next paper is requested.

Respectfully Submitted,



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